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2655/JF
41Practitioner's Docket No. 55784 (70551)
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: J. Nakajima, et al.
Application No.: 09/824,554 Group No.: 2655
Filed: April 2, 2001 Examiner: Hindi, Nabil Z.
For: OPTICAL RECORDING MEDIUM RECORDED WITH INFORMATION IN
DEPTH DIRECTION AND METHOD AND APPARATUS OF
REPRODUCTION THEREFROM

Mail Stop: AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

JUL 09 2004

Technology Center 2600

AMENDMENT TRANSMITTAL

- Transmitted herewith is a Request for Reconsideration for this application.

STATUS

- Applicant is

- [] a small entity. A statement:
[] is attached.
[] was already filed.
[X] other than a small entity.

EXTENSION OF TERM

CERTIFICATE OF EXPRESS MAILING/TRANSMISSION (37 C.F.R. SECTION 1.10)

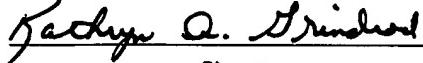
I hereby certify that, on the date shown below, this correspondence is being:

MAILING

- [x] deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 (Express Mail Label No. EV 438974529 US), and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

FACSIMILE

- [] transmitted by facsimile to the Patent and Trademark Office (703) _____.


Signature

Date: June 28, 2004

Kathryn A. Grindrod
(type or print name of person certifying)

NOTE: "Extension of Time in Patent Cases (Supplement Amendments) -- If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

NOTE: See 37 C.F.R. Section 1.645 for extensions of time in interference proceedings, and 37 C.F.R. Section 1.550(c) for extensions of time in reexamination proceedings.

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. Section 1.136 apply.

(complete (a) or (b), as applicable)

- (a) Applicant petitions for an extension of time under 37 C.F.R. Section 1.136 (fees: 37 C.F.R. Section 1.17(a)(1)-(4)) for the total number of months checked below:

	Extension <u>(months)</u>	Fee for other than <u>small entity</u>	Fee for <u>small entity</u>
<input checked="" type="checkbox"/>	one month	\$ 110.00	\$ 55.00
<input type="checkbox"/>	two months	\$ 420.00	\$ 210.00
<input type="checkbox"/>	three months	\$ 950.00	\$ 475.00
<input type="checkbox"/>	four months	\$ 1,480.00	\$ 740.00

Fee: \$ 110.00

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- An extension for _____ months has already been secured. The fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ 110.00

OR

- (b) Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. Section 1.16(b)-(d)) has been calculated as shown below

(Col.1)	(Col. 2)	SMALL ENTITY			OTHER THAN A SMALL ENTITY		
Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra	Rate	Addit. Fee	OR	Rate	Addit. Fee
			\$9.00	\$		\$18.00	\$
Independent Claims Remaining After Amendment	Highest No. Previously Paid For		\$43.00	\$		\$86.00	\$
First Presentation of Multiple Dependent Claim+			\$145.00	\$		\$290.00	\$
					Total Addit. Fee		\$

* If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3,

** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".

*** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".

The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

WARNING: *"After final rejection or action (Section 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. Section 1.116(a) (emphasis added).*

(complete (c) or (d), as applicable)

(c) [X] No additional fee for claims is required.

OR

(d) [] Total additional fee for claims required \$ _____.

FEE PAYMENT

5. [X] Attached is a check in the sum of \$ 110.00.
 [] Charge Account No. _____ the sum of \$ _____.
 A duplicate of this transmittal is attached.

FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).

6. [X] If any additional extension and/or fee is required, charge Account No. 04-1105.

AND/OR

- [X] If any additional fee for claims is required, charge Account No. 04-1105.

Date: June 28, 2004

David A. Tucker

SIGNATURE OF PRACTITIONER

Reg. No. 27,840

David A. Tucker

(type or print name of practitioner)

Attorney for Applicant

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449641



Docket No. 55784 (70551)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: J. Nakajima, et al.

EXAMINER: Hindi, Nabil Z.

SERIAL NO. 09/824,554

GROUP: 2655

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FILED: April 2, 2001

JUL 09 2004

FOR: OPTICAL RECORDING MEDIUM RECORDED WITH
INFORMATION IN DEPTH DIRECTION AND METHOD AND
APPARATUS OF REPRODUCTION THEREFROM

Technology Center 2600

CERTIFICATE OF MAILING UNDER 37 CFR 1.10

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as Express Mail Post Office to Addressee service (Express Mail Label No. **EV 438974529 US**) in an envelope addressed to Mail Stop: Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 28, 2004.

By: Kathryn A. Grindrod
Kathryn A. Grindrod

**Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

Sir:

RESPONSE TO OUTSTANDING OFFICIAL ACTION

This is in response to the Official Action currently outstanding with respect to the above-identified application.

Since no claims are amended, added or canceled by this Response, the claims of this application as they presently stand are not reproduced herein. Claims 1-35 were present in this application as originally filed. As a result of Applicants' election, with traverse, in response to the Examiner's Requirement for Restriction, Claims 13-35 have been withdrawn from further consideration by the Examiner. Accordingly, the claims currently under active prosecution in this application are Claims 1-12.

In the currently outstanding Official Action, the Examiner has:

1. Acknowledged Applicants' claim for foreign priority under 35 USC 119 (a) – (d) or (f), and confirmed the receipt by the United States Patent and Trademark Office of the required certified copies of the priority document therefor;
2. Failed to provide Applicants with an indication concerning the acceptability of the drawings filed with the above-identified application – **an indication as to the acceptability of the drawings currently on file in the above-identified application in response to this communication is respectfully requested;**
3. Provided Applicants with a copy of the Form PTO-1449 filed with their Information Disclosure Statement of November 23, 2003, but unfortunately failed to initial the entry concerning U.S. Patent No. 5,696,757 (document AA) therein; and also failed to provide Applicants with a copy of the Forms PTO-1449 that accompanied the Information Disclosure Statements filed in this case on June 13, 2003 and July 31, 2001, respectively, duly signed, dated and initialed by the

Examiner to confirm his consideration of the art listed therein– **Applicants respectfully request that in response to this communication they be provided with (i) a copy of the Form PTO-1449 filed with Applicants' Information Disclosure Statement of November 23, 2003 correctly signed, dated and initialed by the Examiner to confirm his consideration of the all of the art listed therein; and (ii) copies of the Forms PTO-1449 that accompanied Applicants' Information Disclosure Statements of July 31, 2001 and June 13, 2003, respectively, also duly signed, dated and initialed by the Examiner in confirmation of his consideration of the art listed therein;**

4. Provided Applicants with a copy of a Form PTO-892 and a copy of the references cited therein;
5. Acknowledged Applicants' Response to Restriction Requirement wherein Applicants elected Claims 1-12 for further prosecution in this application with traverse; agreed with Applicants' assertion that they should be entitled to consideration of all claims upon the allowance of a generic claim; agreed with Applicants that Figs. 2 and 3 of the present application disclose only a single embodiment of the present invention; and withdrew claims 13-35 from further consideration in this application, **but failed otherwise to respond to Applicants' traversal of his Requirement for Restriction or to make that Requirement Final;** and
6. Rejected Claims 1-12 under 35 USC 102(b) as being anticipated by EP 1067523.

Further comment on items 1-4 above is not deemed to be necessary in this Response.

With respect to item 5, in response to the Examiner's Requirement for Restriction, Applicants elected, **with traverse**, the Species represented by Figs. 1a-1d upon which Claims 1-12 are readable. That election was made with the understanding that upon allowance of a generic claim, Applicants would be entitled to consideration of claims to additional species that are written in dependent form or otherwise include all the limitations of an allowed generic claim.

The basis for Applicants' traversal of the Examiner's Requirement for Restriction in this case previously was stated to be that all of the claims are directed to the novel technical concept of recording information in the depth direction in the first region of the recording medium. Hence, Applicants asserted that all of the claims of this application should be prosecuted concurrently in a single application. The Examiner has neither responded to Applicants' grounds for traversal of his Requirement for Restriction, nor has he made that Requirement Final. Accordingly, Applicants respectfully request reconsideration of their traversal of the Examiner's Requirement for Restriction.

As Applicants previous argument inherently suggests, all of the present claims deal with the technical subject of recording information in the depth direction of the first region of a recording medium. More specifically, Claims 1-13 deal with an optical recording medium with information recorded in at least a depth direction in first region thereof. Claims 14-15, 18 deal with a method for reproducing/identifying the information recorded in the depth direction of the first region of a recording medium as claimed in Claims 1-13. Claims 16-17 and 19 deal with an apparatus for reproducing/identifying the

information recorded in the depth direction of the first region of the medium claimed in Claims 1-13. Claims 20-31 deal with a recording medium essentially the same as that of Claims 1-13, but in terms of the capability of the medium to have information recorded thereon in the manner specified in Claims 1-13. Claims 32-33 deal with a method for reproducing information recorded in the depth direction in the first region of a recording medium. Claims 34-35 deal with an apparatus for reproducing information recorded in a depth direction of a first region of a recording medium. Accordingly, Applicants respectfully submit that all of the claims of this application are interrelated in that each either specifies a recording medium that can record information in the depth direction of a first region thereof or and apparatus/method for the reproduction of the information recorded in the depth direction of a first region of such a medium.

Consequently, Applicants respectfully again submit that the interrelationships among the various claims of this application are so close that they should be considered together. Indeed, Applicants respectfully note that all of the claims expressly include limitations directed in some way to a recording medium that can record information at least in a depth direction in a first region thereof – some in terms of the recording medium and some in terms of the apparatus and/or method of reproducing the information recorded in the depth direction of a first region of the defined medium. In view of this close interrelationship among the various claims of this application, reconsideration of the Examiner's Restriction Requirement is respectfully requested in response to this communication.

In addition, with respect to the Examiner's withdrawal of Claims 13-35 from further consideration, Applicant respectfully requests that even if the Examiner adheres to his Restriction Requirement in response to the foregoing request for reconsideration, their designation of the claims readable on the elected species be amended so as to include Claim 13. Claim 13 is dependent upon elected Claim 3. Therefore, Applicants respectfully submit that it is axiomatic that it belongs to the same species as its parent claim. Accordingly, Applicants respectfully submit that it is clear that Claims 13 was inadvertently omitted from Applicants' original election in response to the Examiner's Restriction Requirement. A decision modifying Applicants' previous election so as to include Claim 13, therefore, is respectfully requested in response to this communication.

Finally, with respect to the Examiner's substantive rejection of Claims 1-12 as being anticipated by EP 1067523 as mentioned in item 7 above, Applicants respectfully submit that the Examiner's rejection is erroneous in its reliance upon 35 USC 102(b). This is because the reference upon which the Examiner relies was published in January of 2001, while the present application was filed in April of 2001. Accordingly, it will be readily understood that the reference relied upon by the Examiner does not disclose an invention that was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country, more than one year prior to the date of the present application for patent in the United States as required by 35 USC 102(b). Hence, Applicants respectfully submit that the application of the presently cited reference against the present application under 35 USC 102(b) is misplaced and should be withdrawn. A decision so holding in response to this communication is respectfully requested.

Further, to facilitate the prosecution of this application, Applicants are submitting herewith a verified English language translation of the priority document currently on file in this application for the purposes of perfecting their claim for foreign priority. In particular, since Applicants' foreign priority date as so perfected is well prior to the publication date of the reference relied upon by the Examiner, Applicants respectfully submit that the submission of the verified translation of the priority document for this application at this time will avoid any need for the Examiner to correct his grounds for rejection under 35 USC 102. Applicants respectfully submit that the reference currently relied upon by the Examiner cannot be appropriately applied against the present application under 35 USC 102(b), and that by their submission of the enclosed verified translation of the priority document Applicants now have effectively overcome any alternative rejection under 35 USC 102(a). A decision so holding in response to this communication is respectfully requested.

The remaining art cited by the Examiner is suggested to be pertinent to Applicants' disclosure, but is not applied against any of the claims. Further comment on that art in this Response, therefore, is not believed to be necessary.

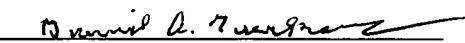
In view of the foregoing Response to the currently outstanding Official Action, Applicants respectfully submit that all of the claims in the present application should be considered on their merits in this prosecution, and that when so considered those claims should found to be in condition for allowance. A decision so modifying and/or withdrawing the currently outstanding Official Action and allowing at least Claims 1-13 (if not claims 1-35) in response to this communication is respectfully requested.

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Finally, Applicants believe that additional fees are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

Date: June 28, 2004


SIGNATURE OF PRACTITIONER

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